

REMARKS

In the Office Action, the Examiner rejected claims 1-9 and 11-19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,839,096 to *Lyons et al.* ("*Lyons*"); and rejected claims 10 and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,232,638 to *Lyons* in view of U.S. Patent Application Publication No. 2004/0148121 to *De Obaldia et al.* ("*De Obaldia*").

By this Amendment, Applicants amend independent claims 1, 10, 11, and 20 to further clarify the previously claimed subject matter, and amend claims 1-7, 9-12, and 20 to correct informalities, correct grammatical errors, and improve clarity. Support for the changes to claims 1, 10, 11 and 20 may be found in the specification at, for example, page 3, paragraph 0013, page 7, paragraphs 0022-0024, and page 9, paragraph 0038.

Claims 1-20 are pending in the above-captioned application.

Rejection Under 35 U.S.C. § 102(b).

Applicants respectfully traverse the rejection of claims 1-9 and 11-19 under 35 U.S.C. § 102(b) as being anticipated by *Lyons*. (Office Action, p. 2.) In order for *Lyons* to anticipate Applicants' claimed invention under Section 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be

shown in as complete detail as is contained in the . . . claim.” (See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).)

Claim 1, as amended, recites “measuring, by at least one sensor of a measurement arrangement which is part of a production line of electronic devices.” *Lyons* fails to teach, at least, this feature of claim 1. *Lyons* apparently discloses a system diagnostic 11 for a collision avoidance system in which a control unit test is performed periodically during the normal operation of an automobile. (Col. 1:57-59 and 6:43-44.) Because the control unit test is performed during the automobile’s operation, *Lyons* clearly does not disclose a “sensor of measurement arrangement which is part of a production line of electronic devices” (emphasis added), as recited in amended claim 1.

In addition, *Lyons* does not disclose “a decision unit for determining a cause of a defect of the electronic device based on the comparison” (emphasis added), as recited in amended claim 1. *Lyons* discloses, for example, “send[ing] an error signal to indicator device 131 which may be a single light on the instrument panel or indicator 131b corresponding to detection unit 117 to alert the driver that the system, or detection unit 117 in particular, is not operating properly.” (*Lyons*, Col. 16:2-8.) However, providing a mere indication that detection unit 117 is not operating properly does not constitute “determining a cause of a defect,” as recited in claim 1.

Since *Lyons* does not to disclose the above-note features of claim 1, the reference fails to anticipate claim 1 under 35 U.S.C § 102(b). Applicants, therefore, respectfully request that the Examiner withdraw the rejection and allow independent claim 1, as well as claims 2-9, which are also allowable at least due to their dependence from claim 1.

Amended claim 11 recites features similar to those of claim 1. For example, claim 11 recites a "measurement arrangement which is part of a production line" and determining a cause of a defect." As discussed above with regard to claim 1, *Lyons* fails to teach these features. Accordingly, for the same reasons as discussed above in regard to claim 1, *Lyons* also fails to anticipate claim 11 under 35 U.S.C. §102(b). Likewise, *Lyons* does not anticipate claims 12-19, at least due to the dependence of these claims from claim 11.

Rejection Under 35 U.S.C. § 103(a).

Applicants traverse the rejection of claims 10 and 20 under U.S.C. § 103(a) as unpatentable over *Lyons* in view *De Obladia*. (Office Action, p. 5.) In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See

M.P.E.P. § 2143. Here, the cited references cannot establish a *prima facie* case of obviousness because, among other things, neither *Lyons* nor *De Obladia*, taken alone or in any proper combination, teach or suggest each and every feature recited in Applicants' claims.

Amended independent claims 10 and 20 recite features similar to those recited in claims 1 and 11 including, "determining a cause of a defect of the mobile phone." Thus, for at least the reasons discussed above with regard to claims 1 and 11, *Lyons* also does not disclose this feature of claims 10 and 20.

De Obladia does not cure the deficiencies of *Lyons*. *De Obladia* discloses a mechanism for testing the transmitter 22 of an integrated RF transceiver. (*De Obladia*, ¶¶ 0026-0027.) The output of the test is a "pass/fail" indication. (*De Obladia*, ¶¶ 0030; Figs. 2 and 4.) A pass/fail indication, however, provides no information about "a cause of a defect," as claimed. Thus, *De Obladia* does not disclose or suggest, "determining a cause of a defect of the mobile phone" (emphasis added), as recited in amended claims 10 and 20.

Since *Lyons* and *De Obladia* fail to disclose or suggest, at least the above-noted elements of claims 10 and 20, the references taken individually or in combination cannot establish a *prima facie* case of obviousness for the rejection of claims 10 and 20 under 35 U.S.C. § 103(a). Accordingly, Applicants' respectfully request that the Examiner withdraw the rejection of claims 10 and 20 and allow these claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants, therefore, request the Examiner's reconsideration and reexamination of the application, and the timely allowance of claims 1-20.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 12, 2006

By: 

Steven L. Ashburn
Reg. No. 56,636